



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/224,262	12/31/1998	KENNETH LAWRENCE ACCARDI	15-SV-4834	3931

7590

11/20/2002

PATRICK S YODER
FLETCHER YODER & VAN
P O BOX 692289
HOUSTON, TX 772692289

EXAMINER

CHEN, TE Y

ART UNIT

PAPER NUMBER

2171

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/224,262

Applicant(s)
Kenneth et al.

Examiner
T. Chen

Art Unit
2171



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 3, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 2171

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 10/03/2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/224,262 is acceptable and a CPA has been established. An action on the CPA follows.
2. Claims 1-28 remain for examination, claims 1,8, 16, 23 have been amended.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2171

3. Claims 1-28 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of copending Application No. 09/199,506. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed medical diagnostic systems comprise substantially the same apparatus and perform the same type of functions, wherein the system comprising: (1) a plurality of medical diagnostic units which including a field service unit were connected to a remote automated medical service facility via a network link; (2) the field service unit is configured to compose service requests based upon predefined service modules of functions; (3) the service request which includes identification of a diagnostic system or facility of interest is communicated to the automated service facility which verifies the request and executes the requested function; 4) medical data gathered from the diagnostic system and service databases; 5) results of the service operation are transmitted back to the requesting unit.
4. Although the claimed grouping or language are different, the essential subject matters and functions of the claimed two systems are the same, thus by using different wording or claim sequencing does not served as a basis for patentability.
5. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 2171

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

7. Claims 1-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Derzay et al. (U.S. Patent No. 6,434,572). .

8. As to claim 1, Derzay et al. taught the invention substantially as claimed, including:

a) a medical diagnostic station configured to store medical image data [12, 88, Fig. 1; col. 1, line 40 - col. 2, line 8];

b) a field service unit configured to generate service requests for operational servicing of the medical diagnostic station, identifying a standard service from a plurality of service functions and a unique identifier for the medical diagnostic station [24, Fig. 1; col. 4, lines 58-61; Fig(s). 6-11, col. 12, lines 25-65];

c) a service facility coupled to the medical diagnostic station and to the field service unit via network links for receiving the service requests from the field service unit and transmitting requested data to the field service unit [Abstract; lines 3-7; 10, Fig. 1].

Art Unit: 2171

9. As to claims 2 and 7, Derzay et al. further disclosed the system comprising a plurality of medical diagnostic stations of different modalities [col. 1, lines 25-38; for example, see 14, 16, 18, Fig. 1], and wherein the standard service functions of service requests include modality-specific functions [col. 8, line 55- col. 9, line 4, 118, 120, 122, Fig. 3].

10. As to claim 3, Derzay et al. further disclosed the field service unit of the system is configured to transmit the service request via an electronic message to the service facility [for example, see Fig(s). 6, 10, etc.], and the service facility is configured to transmit the data to the field service unit via an electronic response message [col. 12, lines 25-32; for example, see Fig. 9].

11. As to claim 4, Derzay et al. further disclosed the service facility is configured to verify consistence between components of the service requests received from the field service unit prior to accessing the data from the medical diagnostic system [254, Fig. 12; 284, 288, Fig. 13; col. 16, lines 24-34; col. 17, line 55 - col. 18, line 2].

12. As to claim 5, Derzay et al. further disclosed the system including at least one database for storing historical service data for the diagnostic station [102, Fig. 2], and the service facility is configured to access the historical service data for response the service request from the field service unit [for example, see Service History button, Fig. 9].

Art Unit: 2171

13. As to claim 6, Derzay et al. further disclosed the service facility is configured to receive the service request, access the data from the diagnostic system and transmit the data to the field service unit automatically and without operator intervention [col. 3, lines 27-37; Fig. 13; col. 18, lines 39-42].

14. As to claims 8-15, these claims repeat either the same limitations of claims 1-7 or well known features in the medical diagnostic system. As the method and architecture of these claims has been shown to be taught or fairly suggested by Derzay et al. As such, these claims are rejected for the same reasons given above.

15. As to claims 16-28, the steps in the claimed method are deemed to be made inherit by the functions of the apparatus structure in the combination discussed above, hence were rejected for the same reasons.

Response to Arguments

16. Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 2171

13. As to claim 6, Derzay et al. further disclosed the service facility is configured to receive the service request, access the data from the diagnostic system and transmit the data to the field service unit automatically and without operator intervention [col. 3, lines 27-37; Fig. 13; col. 18, lines 39-42].

14. As to claims 8-15, these claims repeat either the same limitations of claims 1-7 or well known features in the medical diagnostic system. As the method and architecture of these claims has been shown to be taught or fairly suggested by Derzay et al. As such, these claims are rejected for the same reasons given above.

15. As to claims 16-28, the steps in the claimed method are deemed to be made inherit by the functions of the apparatus structure in the combination discussed above, hence were rejected for the same reasons.

Response to Arguments

16. Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 2171

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Chen whose telephone number is (703) 308-1155. The examiner can normally be reached Monday through Friday from 7:30 A.M. to 4:30 P.M.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached at (703) 308-1436. The fax phone numbers for this group are:

(703) 746-7238 (After Final Communication);

(703) 746-7239 (Official Communications); and

(703) 746-7240 (For Status Inquiries, Draft Communication).

19. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Susan Chen

Nov 15, 2002


SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100